



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,613	09/26/2003	Gerd Dannhardt	104035.269169	3699

826 7590 04/05/2005

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER
----------

COPPINS, JANET L

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,613	<b>Applicant(s)</b> DANNHARDT ET AL	
	<b>Examiner</b> Janet L. Coppins	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9,10,14,15 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 4, 11-13, and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*111*

### **DETAILED ACTION**

Claims 1-7, 9-16, and 18-23 pending in the instant application.

#### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on March 26, 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).
2. Applicant has also not provided a certified copy of the EP 2002/03264 PCT application of March 22, 2002.
3. Accordingly, Applicant cannot obtain benefit of foreign priority papers until the conditions of 35 U.S.C. 119(a-d) have been met.

#### ***Information Disclosure Statement***

4. Receipt is acknowledged of Applicants' Information Disclosure Statement (IDS), filed September 10, 2004. Please refer to the signed copy of Applicants' PTO-1449 form submitted herewith.

#### ***Response to Amendment***

5. Receipt is acknowledged of Applicants' Amendment and Response, filed January 19, 2005, which has been reviewed by the Examiner. Accordingly, claims 8 and 17 have been cancelled, and claims 1, 2, 7, 16, and 19 have been amended.

#### ***Election/Restrictions***

6. The Examiner notes with appreciation the cancellation of the non-elected subject matter from the claims. The Examiner also acknowledges the inadvertent omission of the embodiment in the description of R<sup>11</sup>, within claim 1, wherein R<sup>11</sup> is CH=CH-phenyl, which is meant to be

Art Unit: 1626

included in the elected invention. Therefore, the Examiner withdraws the objections to the pending compound and composition claims.

7. However, claims 21-23, drawn to methods of use, remain withdrawn from consideration, since the product claims from which they depend have not yet been found allowable.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 19, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Niedballa et al, U.S. 4,355,039. Niedballa et al disclose and recite compounds and compositions according to the formula I, in column 1, wherein “Ar<sub>1</sub>” and Ar<sub>2</sub>” are substituted phenyl, “R<sub>1</sub>” is hydrogen or alkyl, “Z” is alkyl or alkenyl substituted by one or two of alkoxycarbonyl, and “n” is 0, 1, or 2.

Said Niedballa et al compounds read on those of the instant claims when R<sup>1</sup> is c) C<sub>1</sub>-C<sub>6</sub> alkenylene-R<sup>7</sup>, where R<sup>7</sup> is ... COOR<sup>8</sup>, wherein... R<sup>8</sup> is H or C<sub>1</sub>-C<sub>6</sub> alkyl.

10. Claims 1-3, 5, 7, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Mustafa, A. et al, Journal fuer Praktische Chemie. Mustafa et al disclose imidazole compounds according to the abstract provided, that read on those of the instant claims when R<sup>1</sup> is b) A-CONR<sup>5</sup>R<sup>6</sup>, in which A is C<sub>1</sub>-C<sub>6</sub> alkylene, in which ...R<sup>5</sup> and R<sup>6</sup> are H, C<sub>1</sub>-C<sub>6</sub> alkyl, or phenyl.

11. Claims 1-3, 6, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Gupta, G. D. et al, Indian Journal of Chemistry. Gupta et al disclose imidazole compounds according to the abstract provided, formula I, that read on those of the instant claims when R<sup>1</sup> is d) C<sub>1</sub>-C<sub>6</sub>

Art Unit: 1626

alkenylene-CO-R<sup>9</sup>, wherein R<sup>9</sup> is phenyl. Please refer to Gupta et al, RN 86628-33-3, for example.

12. Claims 1-3, 9-10, 14-15, 18, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Billheimer, Jeffrey et al, U.S. 5,318,984. Billheimer et al disclose and recite imidazole compounds according to the Formula (I), column 5, wherein "R<sup>1</sup>" and "R<sup>2</sup>" are substituted phenyl, "R<sup>3</sup>" is H or alkyl, "X" is S(O)<sub>r</sub>, "A" is alkyl, "Y" is O, "R<sup>6</sup>" is alkyl, "Z" is NHR<sup>4</sup> or R<sup>4</sup> wherein "R<sup>4</sup>" is alkyl. Tables 1, 3, and 5, teach specific compounds that read on those of the instant claims, please refer to compounds 120, 348, 350, 493, 494, and 495, for example.

#### ***Claim Objections***

13. Claims 4, 11-13, and 16 objected to as being dependent upon rejected base claims.

#### ***Conclusion***

14. Claims 1-7, 9-16, and 18-23 are pending, claims 21-23 are currently withdrawn from consideration, claims 1-3, 5-7, 9-10, 14-15, and 18-20 stand rejected, and claims 4, 11-13, and 16 are objected to.

#### ***Telephone Inquiry***

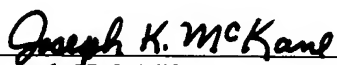
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
March 30, 2005

  
\_\_\_\_\_  
Joseph K. McKane  
SPE, Art Unit 1626